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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional):

4740-212 / P18368-US1

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Date: June 5, 2007

Signature:



Typed or printed name: LAURA WADE

Application Number:

10/676,965

Filed:

October 1, 2003

First Named Inventor:

Chen

Art Unit:

2617

Examiner:

KWASI KARIKARI

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request

This request is being filed with a notice of appeal.

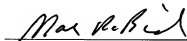
The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor



Signature

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

(Form PTO/SB/96)

Mark R. Bilak

Typed or Printed Name

☒

attorney or agent of record

Registration Number: 47,423

(919) 854-1844

Telephone Number

☐

attorney or agent acting under 37 CFR 1.34.

Registration Number if acting under 37 CFR 1.34

June 5, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ form(s) is/are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Chen et al.

Serial No.: **10/676,965**

Filed: **October 1, 2003**

For: **Method and Apparatus to Improve CDMA
Reverse Link Performance**

Docket No: **4740-212 / P18368-US1**

PATENT PENDING

Examiner: Kwasi Karikari

Group Art Unit: 2686

Confirmation No.: 8121

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June 5, 2007

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Laura Wade

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ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REVIEW REQUEST

Applicants present the following arguments in support of the Pre-Appeal Brief Review Request attached herewith. The Final Office Action (FOA) mailed on March 8th, 2007 rejects independent claims 1, 10, and 17 and various ones of their dependent claims as obvious over U.S. Patent No. 5,625,876 (Gilhausen). These rejections fail as a matter of law because Gilhausen does not teach or suggest all limitations of the rejected claims. Thus, the Office's *prima facie* case in support of the claim rejections has a clear deficiency.

Gilhausen exclusively and explicitly teaches using softer handoff only if defined signal strength conditions are met. To the contrary, the present invention explicitly describes and claims always forcing softer handoff regardless of signal strength conditions. Thus, the Office has either so misconstrued the "forcing always..." claim term such that it no longer has any

appreciable meaning, or worse yet has impermissibly ignored this claim language altogether. Either way, the *prima facie* case supporting the Office's claim rejections is clearly deficient in that Gilhousen does not teach or suggest forcing always-softer reverse link handoff conditions within the meaning of the present specification and claims.

Moreover, the Office's position that Applicants' and Gilhousen's teachings are equivalent is technically erroneous. For example, Gilhousen teaches conditionally assigning an additional reverse link from a non-serving sector of a radio base station when the signal strength of that sector "exceeds a predetermined threshold." See step 2 at col. 8, lines 55-61 of Gilhousen. As such, additional reverse link assignments are made in Gilhousen only when pilot signal strength conditions are met. Otherwise, softer reverse link handoff does not occur. In contrast, the present invention forces always-softer reverse link handoff conditions irrespective of pilot signal strength. To suggest that the two teachings are equivalent blatantly ignores a fundamental feature of Gilhousen – the conditional assignment of reverse links during softer handoff. Thus, the teachings of Gilhousen and the present application not only substantially differ, Gilhousen actually teaches away from Applicants' claimed invention in that Gilhousen teaches the conditional assignment of reverse links only during softer handoff.

In plain error, the Office's key rejection arguments equate Gilhousen's explicitly conditional softer reverse link handoff teachings to Applicants' forcing always-softer reverse link handoff teachings. The Office supports its key rejection arguments at p. 2 and 4 of the FOA where the Office states that Gilhousen "fails to specifically mention forcing always-softer reverse link handoff conditions", but does mention softer handoff conditions. Page 3 of the FOA further states that Gilhousen teaches the functionality taught by Applicants' invention and that the Applicants merely "coined" the "forcing always...." language in their specification and claims. The Office's position of record strongly suggests that the Office considers the "forcing always...." claim language merely superfluous, and thus gives it no weight.

The Office's position of record is clearly erroneous in both law and fact. The Office apparently substantiates its position by ignoring the "forcing always" claim language. Of course, the Office may give claim terms their broadest reasonable construction, but the construction must be consistent with the specification and claims. *Phillips v. AWH Corp.*, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005). Here, Applicants have not fabricated or otherwise "coined" new terminology as suggested by the Office when claiming their invention. Instead, the words at issue – "forcing" and "always" – have well-defined plain and ordinary meanings which are not contradicted in any way by the present specification and claims. From Dictionary.com, "to force" is defined as "to compel, constrain, or oblige" while "always" means "every time; on every occasion; without exception." The present application consistently uses the words "force" and "always" to convey the idea of using otherwise conventional softer reverse link handoff capabilities to improve reverse link signal reception by always forcing the assignment of additional reverse links irrespective of whether the corresponding radio sectors are suitable for making forward link assignments. See Spec. ¶ [0007].

The present specification and claims are replete with examples demonstrating consistent and well-defined use of the words "forcing" and "always" as used in the context of forced reverse link handoff. For example, ¶ [0022] of the specification states that "extra" or additional reverse link assignments for a mobile station can be assigned whenever a radio base station sector serves the mobile station. Thus, the additional reverse links are not conditionally assigned, e.g., based on pilot signal strength measurements as taught by Gilhausen. Instead, they are forced regardless of pilot signal strength measurements. Further, the additional reverse links are not temporarily assigned only when a mobile station moves between radio sectors of a multi-sector base station as is conventionally done. Instead, the additional reverse links are always forced.

In another example, ¶ [0029] of the specification states that always-softer reverse link handoff conditions are forced by assigning one or more reverse links to a mobile station from “horizontal neighbor” sectors. The “horizontal neighbor” sectors are defined as other sectors at the same radio base station that operate on the same carrier frequency used for reverse link assignments made to the mobile station in the serving sector. In yet another example, ¶ [0032] of the specification states that “the present invention markedly departs from the conventional approach by forcing the always-softer handoff condition at serving RBSs on the mobile station’s reverse link irrespective whether the mobile station is in softer handoff at the RBS on the forward link” (where RBS refers to a radio base station). Thus, “forcing always-softer reverse link handoff conditions” as used in the present specification and claims is not equivalent to conventional softer reverse link handoff techniques such as those taught by Gilhousen because additional reverse links are not conditionally assigned according to the present invention, but instead are always forced.

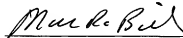
The rejection of dependent claims 4 and 13 is another example of the Office’s failure to satisfy its burden of establishing a *prima facie* case of obviousness. Claims 4 and 13 recite the further limitation of assigning one or more additional reverse links irrespective of whether the corresponding sectors are included in a current active set of the mobile station. As stated previously, Gilhousen conditionally assigns additional reverse links when pilot signal strength exceeds a predetermined threshold. The Office simply ignores the irrespective limitation of claims 4 and 13.

The Office rejects various other dependent claims as being unpatentable over Gilhousen further in view of either U.S. Patent No. 6,011,787 (Nakano) or U.S. Publication No. 2002/0154610 A1 (Tiedemann). However, neither Nakano nor Tiedemann cure the legal and technical deficiencies of Gilhousen, and thus, the corresponding rejections fail for at least those reasons given earlier.

In light of the above remarks, applicants submit that all claims are not obvious over Gilhousen. As such, applicants respectfully request that the Office withdraw all rejections outstanding in the FOA as being in clear legal and technical error, and allow the present application.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.



Dated: June 5, 2007

Mark R. Bilak
Registration No.: 47,423

1400 Crescent Green, Suite 300
Cary, NC 27518
Telephone: (919) 854-1844
Facsimile: (919) 854-2084